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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,686	04/06/2001	John Rizzotto	PAR-100US	5077

7590 12/06/2002  
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EXAMINER

WALLS, DIONNE A

ART UNIT PAPER NUMBER

1731

DATE MAILED: 12/06/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/827,686

Applicant(s)

RIZZOTTO ET AL.

Examiner

Dionne A. Walls

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 18-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 18-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102/103*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 7-8, 18-19, 24-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Finberg (US. Pat. No. 3,067,068).

Finberg discloses a chewing composition/tobacco substitute comprising cabbage leaves as a carrier, in combination with papaya leaves, both of which are heated such that, in the final product, the water content is between about 5 and about 14 percent by weight (corresponding to the claimed "moisture content at or below 8% by weight"). The chewing composition may include humectants, such as glycerin; flavoring agents, such as apple cider (corresponding to the claimed "water soluble but not water containing flavoring ingredient...liquid form"); and other sweetening agents, such as vanillin. Finberg teaches that the chewing composition can be produced in any conventional

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form, including shredded/strand form. (col. 5, line 52-col. 6, line 34; col. 7, line 68, col. 10, line 17-col. 12, line 17; see examples 1-4). While Finberg may not specifically state that the plant material has at least 30% intact cell walls, it is assumed that the cabbage leaves of its invention inherently possesses this characteristic since there is no requirement that, during the processing of the chewing product, the leaf composition be ground or finely chopped, which could break the cellular structure of the vegetable material. In the alternative, the cell walls of Finberg would obviously be at least 30% intact due to the fact that that leaves comprising the chewing composition are merely mixed together, heated under pressure, and molded into a desired shape for subsequent shredding or the like. Further, it follows that the flavoring ingredients would be such that they would be capable of entering said cell walls since this must occur in order to appreciate the benefits of the ingredients in the final product.

***Claim Rejections - 35 USC § 103***

4. Claims 3-6, and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finberg (US. Pat. No. 3,067,068) in view of Garber (US. Pat. No. 2,331,830).

While Finberg may not specifically state that the cellulosic plant material of its invention is in a granular form, it does state that the chewing composition can be in any form that such compositions are conventionally provided (col. 5, lines 52-53). Further, Garber discloses chewing tobacco compositions that can be provided as granular particles (page 2, col. 2, lines 32-33). Therefore, it would have been obvious to one

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having ordinary skill in the art at the time of the invention to provide the chewing composition of Finberg in the form of granules since this form of chewing tobacco is known in the art as evidenced by the Garber disclosure.

Regarding claims 4-6 and 21-23, while there may be no specific articulation of the claimed mesh sizes for the chewing composition of Finberg modified by Garber, it would have been obvious to one having ordinary skill in the art at the time of the invention to optimize the granule size and arrive at the claimed mesh sizes, after routine experimentation, in order to produce a chewing composition with granules having ideal surface area to effectively hold the conditioning agents. "Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454,456, 105 USPQ 233,235 (CCPA)

5. Claims 9 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finberg et al (US. Pat. No. 3,067,068) in view of Nonomura et al (US. Pat. No. 5,597,400) and Payne (US. Pat. No. 4,946,697).

While the chewing composition of Finberg may not specifically state that the cabbage used in its tobacco substitute is green cabbage, this limitation is not deemed to impart any patentable distinction to the claims because green cabbage classified as *Brassica oleracea capitata* is a commercially known plant/vegetable material, as evidenced by the Nonomura et al reference (col. 11, lines 8-9). Therefore, one having ordinary skill in the art would have been motivated to use it as the cabbage leaf vegetable material in the chewing composition of Finberg because of its market

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availability. Further, while Finberg modified by Nonomura et al may not disclose that the cabbage of its chewing composition is "freeze dried", it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the green cabbage in "freeze-dried form" since vegetable products are conventionally freeze-dried in order to retain their internal cell structure and to improve their overall quality and flavor, as evidenced by the Payne reference (col. 2, lines 18-28).

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-9 and 18-26 are have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

A handwritten signature in black ink, appearing to read "Dionne A. Walls". The signature is fluid and cursive, with a long horizontal stroke extending to the right.

Dionne A. Walls  
December 2, 2002